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EXAMINER

NGUYEN, MINH CHAU

ART UNIT PAPER NUMBER

2145

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|---------------------------------------|--|
| Office Action Summary | Application No. 09/883,419 | Applicant(s) OONUKI, TAKASI | |
| | Examiner MINH-CHAU N. NGUYEN | Art Unit 2143 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/18/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims Analysis

1. Claims 1-8 are pending for examination. The objection and/or rejection are cited as stated below.
2. Claims invention, in context, directed to a system and method of an electronic mail (email) communication system which allows users to send or access the personal information. The system required computers (user terminal) and server (personal information server) which is providing personal information on a user terminal through the Internet. User can be a sender or a receiver. Personal information transmission which for transmitting the personal information of user from a user terminal to the server. Electronic mail transmission which is allowing user to use a program to create email and transmit this email to server or other user terminals. Moreover, recipient information generation which is allowing a sender sends the receiver's information (such as email address, etc.) to the server. Electronic mail reception which user can receive email. Personal information acquisition which is allowing the receiver to request the sender's personal information. When receiver receive an email from the sender, he/she could send a request to the server to have the sender's personal information. The server would reply the acquired personal information to the receiver for displaying this information on the receiver terminal. In addition, personal information registration which is allowing user from user terminal to register his/her personal information and then transmit it as a file to the server. Empowering which means the sender has described the receivers whom the sender

allows the server transmits his/her personal information in recipient information.

Personal information providing which is allowing the server transmits the sender's personal information to the request of particular receivers. Further even though, the claims' language required an empowering in the electronic mail communication.

However, regardless of such requirement, the claims recited functionalities of a conventional electronic mail system. Thereby, the claims are interpreted as such.

Base on the aforementioned analysis, claims 1-8 are rejected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 1 is a single step claim, i.e., where a step recitation does not appear in combination with another steps, is subject to an undue breadth, a rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for

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achieving the stated property (result) while the specification discloses at most only those known to the inventor.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step(s) that correlates the step of matching information with notifying user, such claim's language is vague, unclear whether matching information can construct notifying users as defined in the preamble of the claim.
7. Claim 1 and 5 provide for the use of a system/method of notifying users, but, since the claim does not set forth any steps involved in the system/method, it is unclear what system/method applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.
8. In claim 1, "only to one or more requesters" is unclear and vague. It is only one requester or it is many requesters. "Only" is unclear. The Examiner will interpret that "only to one or more requesters" to mean only one requester.
9. In claim 2,

- “providing personal information on a user”; “transmitting the personal information on the user”; “user to receive the electronic email”; and “recipient information on a recipient based on the electronic mail transmitted” are unclear and vague. It is not clearly understood meaning of “a user” is user human or user terminal, and “a recipient” is receiver or recipient paper or recipient terminal, as used within the claims. The Examiner will interpret that “a user” and “a recipient” to mean user terminal and recipient terminal.
- “personal information transmission means for transmitting the personal information on the user to the personal information server” is indefinite. It is just about user and server.
- “electronic mail transmission means for allowing said user to create and transmit an electronic mail” is indefinite. It is just about a program and the server.
- “request personal information on a sender of the electronic mail” should be request information of a sender of the electronic mail.

10. In claim 4, “recipient information generation” is unclear and vague. It is not clearly understood meaning of “recipient information shall not be generated” is recipient information whose have not been in a user’s file contact, so whenever the user receive a message from other user, the user will add his/her email address into the file contact to be the recipient information but not generate his/her information and the user still could transmit email to him/her; or recipient information whose information is not generate even though his/her email is records into a file and after then the user would not transmit email to him/her.

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11. The claims 1-8 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Appropriated corrections are required to the claims and all other similar languages, which may have been oversight by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claim Claim 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Futagami et al. (Futagami), (US 6,754,665 B1).

13. Regarding claim 1, Futagami teaches a personal information providing system for providing personal information on a user through the Internet, comprising:

a provider for providing the personal information on the user only to one or more requesters with whom the user has communicated by electronic mail [Abstract, and Col. 1, L. 37-40].

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14. Regarding claim 2, Futagami teaches a personal information providing system, comprising a user terminal and a personal information server, for providing personal information on a user through the Internet, where in

said user terminal comprises:

personal information transmission means for transmitting the personal information on the user on the personal information server (Futagami teaches the management server receives personal information of user of the computers. In the other word, the personal information of user is transmitted to the management server), [Col. 4, L. 13-16].

electronic mail transmission means for allowing said user to create and transmit an electronic mail (Futagami teaches a mailer which is an application program for users send or receive electronic mails), [Col. 1, L. 41-46].

recipient information generation means for transmitting to the personal information server recipient information on a recipient based on the electronic mail transmitted from said user (Futagami teaches a user of the computer wants to register the personal information of the user of the personal telephone device into the address table, the user of computer sends the information of the user of the personal telephone device to the management server), [Col. 4, L.31-44].

electronic mail reception means for allowing said user to receive the electronic mail (Futagami teaches a user uses of the computers or the portable telephone device can send an email to each other that means they also can receive an email, too), [Col. 1, L.37-40].

personal information acquisition means for allowing a recipient who has been received an electronic mail to request personal information on a sender of the electronic mail, for acquiring the personal information on the sender from said personal information server, and for displaying the acquired personal information (Futagami teaches a user want to acquire personal information of another user from the management server, the user inputs a personal information request command together with a keyword (ex: email address of the user whose personal information is to be acquired, etc.) to the management server), [Col. 5, L. 44 – Col. 6, L. 24].

personal information registration means for receiving the personal information on said user from said user terminal, and for registering the received personal information with a personal information file (Futagami teaches a user register his/her personal information into the management server), [Col. 5, L. 8-40].

empowering means for receiving recipient information from said user terminal and for empowering the recipient who is described in said recipient information to refer to the personal information on said user (Futagami teaches that the management server controls the access of a user to personal information of other users in accordance with the access restriction information. In general, the owners of personal information want to provide their personal information to only particular users whom are authorized), [Col. 13, L. 43-52 and Col.14, L. 4-8].

personal information providing means for transmitting the personal information on said user to said recipient if said recipient requesting the personal information on said user is empowered to refer to the personal information on said user. (Futagami teaches

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a personal information providing process performed by the management server where in access to personal information is restricted in accordance with the access restriction information. If the user of the client terminal which has issued the retrieval request is permitted to access the personal information, so the management server transmit the personal information to the client terminal) [Col. 14, L. 49 – Col. 15, L. 34].

13. Regarding claim 3, Futagami teaches a personal information providing system according to claim 2, wherein

said user terminal further comprises means for generating cancellation information describing information on a person being forbidden, and for transmitting the generated cancellation information to said personal information server (Futagami teaches the owners of personal information transmit a restriction information which restrict/cancel the providing of personal information to certain users to the management server) [Col. 13, L. 48-67];

said personal information server further comprises means for receiving said cancellation information, and for canceling power of a person described in said cancellation information to refer to the personal information on said user (Futagami teaches the management server controls the access of a user to personal information of another user in accordance with the access restriction information (allow or not allow to access). Thereby, the management server would receive the restriction information from other users which is not permitted to be accessed by the user, the management server

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will transmit a refusal message to the user which tell that access is not allowed) [Col. 13, L. 59-67 and Col. 15, L. 40-52].

14. Claims 5-7 have similar limitations as claims 1-3, respectively, therefore are rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Futagami as applied to claim 2 above, and further in view of Hall (US 6,643,686 B1).

16. Regarding claim 4, Futagami is relied upon for the disclosure set forth in the claim 2 rejection. Futagami fails to disclose the user would add a recipient's email address into an exclusive file which recipient information shall not be generated. However, Futagami suggested that a user record personal information such as names, and email addresses of other users into an address table, such suggestion would motivate one ordinary skilled in the art to seek a practical and effective way of doing so. Hall, in the same field of endeavor having closely related objectivity, teaches the personal information providing system according to claim 2, wherein

said recipient information generation means is provided with a exclusion file for registering at least an electronic mail address of a recipient for whom recipient information shall not be generated (Hall teaches a filtering spam is called Collaborative Filtering which many users report spam messages (include spammer's email address) to a central server and makes a list of such messages globally available to all users, so that these spammer's information not need to be generated.), [Col.9, L. 65 - Col.10, L. 9], and wherein

said recipient information means does not generate said recipient information if the mail address of the recipient of said transmitted electronic mail is included in said exclusion file (Hall teaches a user's mail software receives a new message, it checks it against the server's list; if found, a message or a spammer's information is discarded.), [Col. 10, L. 1-3].

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated a file is transmitted to the server for filtering received message information, as suggested by Hall, in the personal information processing apparatus of Futagami, in order to easily control access to personal information of a user.

17. Claim 8 lists all of the same elements of claim 4 but in method form rather than system form. Therefore, the same rationale of the rejection to claim 4 applies equally as well to claim 8.

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18. Examiner noted that the claims are presented in means plus function language.

Examiner suggested that applicant should invoke 35 U.S.C. 112, sixth paragraph.

35 U.S.C. 112, sixth paragraph require:

- a) Show why the claim language properly invokes 35 U.S.C. § 112, sixth paragraph, e.g., including “means for” or “step for” in the claim;
- b) Identify the function;
- c) Identify the corresponding structure and detail description in the specification;
- d) Specifically point out structure corresponds to the recited function with reference to the claimed terms and phrases, provided no new matter is introduced.

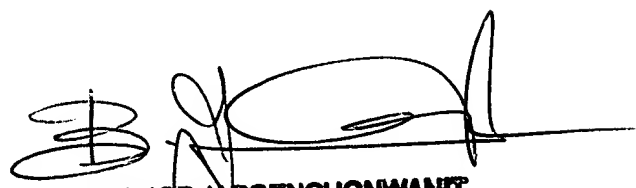
The “means for” has readily been presented in the claims language. Applicant is suggested identify the requirement in point (c) and (d) to property invoke 35 U.S.C. 112, sixth paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-CHAU N. NGUYEN whose telephone number is (703)305-8425. The examiner can normally be reached on Monday-Friday from 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID A. WILEY can be reached on (703)308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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